

REMARKS

Claims 1-33 remain pending and under current examination. By this Amendment, Applicants amend claims 1 and 23-33 to more particularly define the scope of the invention.

In the Office Action,¹ the Examiner states "Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of new grounds of rejection" (Office Action at p. 11). The Examiner rejected claims 1-10, 16-20, and 23-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,890,135 to Powell ("*Powell*") and Official Notice; rejected claims 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable over *Powell* in view of U.S. Patent No. 6,167,383 to Henson ("*Henson*"); and rejected claims 11-15 under 35 U.S.C. § 103(a) as unpatentable over *Powell* in view of U.S. Patent No. 5,774,870 to Storey ("*Storey*").

Applicants respectfully traverse the Examiner's rejections for the following reasons.

- I. **The rejection of claims 1-10, 16-20, and 23-33 under 35 U.S.C. § 103(a) as being unpatentable over *Powell* and Official Notice is improper.**

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-10, 16-20, and 23-33 because a *prima facie* case of obviousness has not been established with respect to these claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, neither *Powell* nor the Examiner's "Official Notice," taken alone or in combination, teach or suggest each and every element of Applicants' claims.

Amended claim 1 recites a combination including, for example:

an information distribution apparatus associated with a purchase information trader, including:

...
a use log counting unit configured to count the use record for a store which makes a contract with the purchase information trader for distribution of coupon information, and to output a request of charge of distribution based on the counted result;
wherein said first communication unit sends the request of charge to a sale apparatus of the store,

...
the sales apparatus located at the store, including:
a third communication unit coupled to a wireless connection;
...
wherein said third communication unit receives the request of charge from said information distribution apparatus.

(emphasis added). *Powell* does not teach or suggest at least these elements.

Powell recites that the computer "stor[es] the coupon on each of portable cards" (*Powell*, col. 3, lines 54-55). Users take the portable card to a store for a purchase (*Powell*, col. 3, lines 56-57). Such teachings do not constitute a teaching or suggestion of a information distribution apparatus including

a use log counting unit configured to count the use record for a store which makes a contract with the purchase information trader for distribution of coupon information, and to output a request of charge of distribution based on the counted result;
wherein said first communication unit sends the request of charge to a sale apparatus of the store,

as recited by claim 1.

Moreover, the Examiner concedes that *Powell* fails to teach or suggest a wireless communication network (Office Action at pp. 3-4). Nevertheless, the Examiner relies on Official Notice, alleging “wireless connections to various communications networks ... are old and well known” (Office Action at p. 3). Even assuming the Examiner’s citation of Official Notice is proper and even assuming the assertion regarding wireless communications networks is true, the assertion fails to make up for the deficiencies of *Powell* discussed above. That is, the Examiner has not asserted Official Notice of an information distribution apparatus including

a use log counting unit configured to count the use record for a store which makes a contract with the purchase information trader for distribution of coupon information, and to output a request of charge of distribution based on the counted result;
wherein said first communication unit sends the request of charge to a sale apparatus of the store,

as recited by claim 1.

Because the cited references fail to teach or suggest each and every claim element recited by claim 1 and required by dependent claims 2-10, 16-20, and 23, no *prima facie* case of obviousness has been established with respect to these claims. Applicants therefore respectfully request the Examiner to withdraw the rejection of claims 1-10, 16-20, and 23 under 35 U.S.C. § 103(a) as being unpatentable over *Powell*.

Independent claims 24-33, although of different scope, recite elements similar to elements recited by claim 1, which are also not taught by the cited references.

Accordingly, at least for the reasons discussed above with respect to claim 1, no *prima facie* case of obviousness has been established for claims 24-33. Applicants therefore respectfully request the Examiner to reconsider and withdraw the rejection of claims 24-33 under 35 U.S.C. § 103(a) as being unpatentable over *Powell*.

II. The rejection of claims 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable over *Powell* in view of *Henson* is improper.

Claims 21 and 22 depend from claim 1 and therefore include all of the elements recited in claim 1. As discussed above, *Powell* fails to teach or suggest each and every element recited by claim 1 and required by claims 21 and 22.

The Examiner relies on *Henson* for allegedly teaching “receiving user feedback (selections) and analyzing such feedback to select information to provide to the user” (Office Action at p. 8). Even assuming this assertion is correct, *Henson* fails to cure the deficiencies of *Powell* discussed above. That is, *Henson* fails to teach or suggest an information distribution apparatus including

a use log counting unit configured to count the use record for a store which makes a contract with the purchase information trader for distribution of coupon information, and to output a request of charge of distribution based on the counted result;
wherein said first communication unit sends the request of charge to a sale apparatus of the store,

as required by claims 21 and 22.

Because neither *Powell* nor *Henson*, taken alone or in combination, teach or suggest each and every element required by dependent claims 21 and 22, no *prima facie* case of obviousness has been established with respect to these claims.

Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable over *Powell* in view of *Henson*.

III. The rejection of claims 11-15 under 35 U.S.C. § 103(a) as unpatentable over *Powell* in view *Storey* is improper.

Claims 11-15 depend from claim 1 and therefore include all of the elements recited in claim 1. As discussed above, *Powell* fails to teach or suggest each and every element recited by claim 1 and required by claims 11-15.

The Examiner relies on *Storey* for allegedly teaching “promotional information pertaining to games or coupons” (Office Action at p. 9). Even assuming this assertion is correct, *Storey* fails to cure the deficiencies of *Powell* discussed above. That is, *Storey* fails to teach or suggest information distribution apparatus including

a use log counting unit configured to count the use record for a store which makes a contract with the purchase information trader for distribution of coupon information, and to output a request of charge of distribution based on the counted result;
wherein said first communication unit sends the request of charge to a sale apparatus of the store,

as required by claims 11-15.

Because neither *Powell* nor *Storey*, taken alone or in combination, teach or suggest each and every element required by dependent claims 11- 15, no *prima facie* case of obviousness has been established with respect to these claims. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 11-15 under 35 U.S.C. § 103(a) as being unpatentable over *Powell* in view of *Storey*.

IV. Conclusion

In view of the foregoing remarks, Applicants respectfully request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

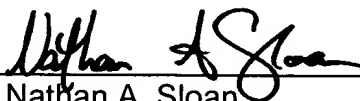
Should the Examiner continue to dispute the patentability of the claims after consideration of this Reply, Applicants encourage the Examiner to contact Applicants' undersigned representative by telephone to discuss any remaining issues or to resolve any misunderstandings.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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